



Reply Brief
#19 373

Attorney Docket No. G3752

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	Marco STEIGER et al.
Serial No.	09/917,998
Filed	07/30/2001
For	MATERIAL REMOVING TOOL
Supervisory Primary Examiner	Mr. Joseph J. Hail, III
Group Art Unit	3723

REPLY BRIEF TO THE EXAMINER'S ANSWER

Hon. COMMISSIONER FOR PATENTS
P.O.Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Brief is in reply to the EXAMINER'S ANSWER mailed January 14, 2004, and more specifically in reply to the **Grounds of Rejection** on pages 3-6 as well as to the **Response to Argument** on pages 6-9 of the ANSWER.

(1) The arguments in the paragraph bridging pages 3-4 of the ANSWER are believed (a) to be non-responsive to the arguments on pages 12-19 of appellants' Brief dated September 11, 2003, and (b) to warrant full reconsideration on several grounds including the following:

The Examiner failed to recognize the importance of the preamble of appellants' independent claim 1 and

of claims which refer to claim 1. The importance of the preamble is fully explained and substantiated in the aforementioned passage of appellants' Brief. The word "preamble" is not even mentioned in the Answer, probably because the Examiner was unable to present a single convincing rebuttal of appellants' explanations of differences between the preamble of their independent claim 1 on the one hand, and the teaching of the primary reference Fletcher et al. (hereinafter Fletcher) on the other hand. It is to be borne in mind that the device which is disclosed by Fletcher cannot (emphasis by the undersigned) perform work of the type clearly pointed out in the preamble of appellants' claim 1, namely to make cuts which are bounded by walls and have predetermined widths.

The entire tenor of the disclosure in Fletcher is that the patented blade is to cut across or into a bone in such a way that the bone is divided into discrete parts or, perhaps (but this is not stated in the patent) to make slits if the cutting across the bone is not completed. This is believed to be substantiated by several passages in the primary reference as well as in the drawing. Please refer, for example, to Fig. 5B of Fletcher which shows that the cutting edge of the blade 30 is longer than the schematically illustrated non-referenced bone. Thus, all this blade can do is to cut across the

entire bone or, if the cut across the bone is not completed, to make in the bone a cut which is open at both its ends as well as at the side where the blade has penetrated into the bone. Reference may also be had to the paragraph in lines 44-48 of column 3 in the patent to Fletcher where the patentees specifically point out that their device cuts through the bone (emphasis by the undersigned).

On the other hand, appellants disclose and claim a tool which can make in a plastic, metallic, wooden or other workpiece a cut having a predetermined width and bounded by walls. Thus, a cut which can be made by appellants' tool need to be open at one side only, namely at the side where the tool has penetrated into the workpiece. Since the just outlined utterly novel feature is evidently pointed out in the independent claim 1 and hence also in each of the claims which refer to claim 1, all of these claims are believed to be directed to novel and patentable subject matter. This is not a conclusion which is asserted by appellants but rather a fact which is substantiated by numerous decisions of US Federal Courts including those specifically pointed out in appellants' Brief.

(2) It is believed that the Examiner misinter-

preted the disclosure of Fletcher. Please refer to the sentence in lines 6-8 of the last paragraph on page 3 of the EXAMINER'S ANSWER. The slot 24 shown in certain Figures of the patentees' drawing does not serve to facilitate removal of cut material or the patentees evidently failed to recognize the possibility of utilizing the slot for such purposes. Please refer to the paragraph in lines 41-48 in col. 4 of the reference where the patentees explain that "In addition to providing a lighter blade, the diamond shaped orientation (of the cutout 24) tends to assist in tooth profiling during fabrication". This appears to be the only passage of the specification of Fletcher which refers to the cutout 24. Consequently, the rejection of appellants' claims 13, 20 and 21 appears to be based on an erroneous interpretation of the primary reference and should be reconsidered.

(3) Appellants' claim 1 recites that the second section of the tool is "arranged to make in a workpiece a cut having a width which is a function of the extent of oscillatory movement of said output shaft, of the distance from said axis to said cutting edge and of the length of said cutting edge". This very important feature is not disclosed, suggested and/or implied within

the four corners of the primary reference. Furthermore, the Examiner failed to discuss this feature, probably because nothing in the patent to Fletcher is even remotely suggestive of such utterly novel, important and non-obvious characteristic of appellants' tool. Thus, appellants can determine, in advance (emphasis again by the undersigned), the nature of the cut to be made by the improved tool, and this can be achieved in a manner as pointed out in lines 13-17 of claim 1 (as it appears on page A of the appendix to appellants' Brief). It is believed that this feature alone suffices to warrant withdrawal of Fletcher from further consideration in connection with the finally rejected claim 1, with all claims which depend from the claim 1, and also with the claim 19.

Appellants sincerely believe that one cannot give credence to a final rejection which fails to mention and/or point out the importance or lack of importance of a clearly pointed out passage in a claim, especially an independent claim which is parent to a substantial number (13) of dependent claims (in a total of 20 claims). A final rejection, particularly in an Examiner's Answer, cannot disregard (i.e., avoid the discussion of) that feature or those features of a finally rejected claim which the Examiner is unable to locate in the prior

art. Attention is respectfully invited to the request on page 25 of the Brief dated September 11, 2003.

(4) Since all of the claims which are active in this case stand rejected on Fletcher alone, or on a combination of Fletcher with additional art, appellants believe that the final rejection of all claims should be reversed in its entirety. Furthermore, appellants find that the rejections of at least some of their claims on a combination of Fletcher with additional references are not convincing for additional reasons some of which will be pointed out hereinbelow.

In rejecting the claims 7 and 8, the Examiner relied on Fletcher and upon his opinion that "where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art". Appellants believe that such reasoning is erroneous, especially in the absence of any case law which would support the Examiner's position. Please refer, for example, to the decision by the CAFC in *In re Newell* (decided Dec. 12, 1989 and reported in 13USPQ2nd 1248) wherein it was held that

"Determination that novel combination would have been obvious requires supporting teaching in prior art, and retrospective view of inherency cannot serve as substitute for

actual teaching or suggestion in prior art which supports selection and use of various elements in particular claimed combination."

Furthermore, the Examiner failed to note that "... superiority over prior art is not required for patentability" (Ryco Inc. v. Ag-Bag Corp., CAFC decided September 21, 1988 and reported in 8 USPQ2d 1323).

(5) In his Response to Argument, the Examiner again made several observations which, in appellants' opinion, are plainly erroneous. For example, in paragraph 11 on page 6 of the ANSWER, the Examiner asserts that "structurally every limitation of the appellants' claims 1 and 21 ... is met by the Fletcher reference. The appellant is not claiming the member in combination with the oscillating tool". This interpretation of appellants' claims is believed to be plainly erroneous. Please refer, for example, to the decision (Corning Glass Works v. Sumitomo Electric U.S.A.) which is discussed on page 16 of appellants' Brief and wherein the CAFC held that

"The district court correctly interpreted the preamble of the claim ... as a structural limitation on the scope of the claims rather than a statement of purpose."

It is evident that the Examiner's arguments in the paragraph 11 of his ANSWER are not in consonance with the interpretation of the preambles of US patent claims by

the CAFC. This alone suffices to warrant full reconsideration of the rejection of each and every claim (emphasis again by the undersigned) which is active in this case. Please compare the language of the decision by the CAFC with the Examiner's assertion that "The appellant is not claiming the member in combination with the oscillating tool". On the contrary, each and every claim now pending in this case calls for a combination of "the member with the oscillating tool".

For the foregoing reasons, and those expounded in the Brief dated September 11, 2003, appellants believe that the final rejection of all claims which are active in this case should be reversed in its entirety. Such disposition at a reasonably early date is earnestly solicited.

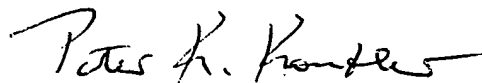
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Respectfully submitted,


Peter K. Kontler
Reg.No. 20,384
Attorney for Appellants
Phone: (239) 262-8492
Facsimile: (239) 434-6747
Address:
4401 Gulf Shore Blvd. North
Naples, FL 3413-3450